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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,577	04/14/2004	Jung-Yao Tsai	3624-0165PUS1	5024
2292	7590	10/07/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SAVAGE, JASON L	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,577

Applicant(s)

TSAI, JUNG-YAO

Examiner

Jason L. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,945,307. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to golf club heads that are formed by casting and then forging a predetermined shape to form a striking face on the golf club head. US Patent 6,945,307 further claims that Fe-Mn-Al, AISI 4130 steel and AISI 8620 steel are used.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(f) he did not himself invent the subject matter sought to be patented.

Claims 1-5 are rejected under 35 U.S.C. 102(f) as being anticipated by the admitted prior art.

Applicant states the cast golf club head blank in figures 2D and 2E is prior art formed from conventional casting process (p. 2, ln. 12-22). Applicant further states that the forging blank of the present invention can be obtained by the casting process of Figures 2A-2E (p. 6, ln. 17-22). As such, the admitted prior art anticipates the claims in that it teaches blanks which are capable of being used in a forging process which are formed by casting comprising a bending portion, a club head and hosel.

Regarding claim 2, the head and hosel portions of the admitted prior art are substantially circular.

Regarding claim 3, the club head in Figure 2E has a sectional area greater than the hosel. Regarding the limitation that the blank is forged to form a golf club head having a striking face, the claims are drawn to the product, not the method of making. As was admitted by Applicant, the blank of the prior art is subjected to several surface finishing procedures to obtain a final product of a golf club head which would inherently have a striking face (p. 2, ln. 21 – p. 3, ln. 1).

Regarding claim 5, although Applicant states that there is difficulty with processing the claimed metal materials to form the cast blank (p. 3, ln. 16 – p. 4, ln. 3), the admission that the materials have been used to form castings anticipates the claim limitations.

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Claims 1, 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by McCabe (US 6,524,194).

McCabe teaches first portion **22** of a golf club head which comprises a bending portion, a club head portion and hosel portion (Figures 1-2). Although the golf club head depicted is in a finished form, the claim does not preclude the blank from being in finished form and only requires that the golf club head have the recited structural elements.

Regarding claim 3, the golf club head first portion **22** meets the claim limitation of being a golf head body having a striking face.

Regarding claim 4, the formed golf club head **20** in Figure 1 of McCabe meets the claim limitations wherein the striking face of the first portion **22** is smaller than that of the hosel portion and a weight member **28** is bonded to the rear side of the striking portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,524,194).

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McCabe teaches what is set forth above however it is silent to the structure of the intermediate golf head casting blank. However, absent a showing of unexpected results, the claimed circular cross section of the club head and hosel portions are merely design choices which do not patentably distinguish the present invention over the prior art of record. *Eskimo Pie Corp. v. Levous et al.*, 3 U.S.P.Q. 23. *In re Rose* 105 U.S.P.Q. 237. *In re Dailey* 149 U.S.P.Q. 47.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,524,194) in view of Hsieh (US 5,167,733).

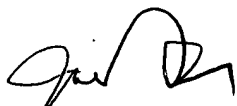
McCabe teaches that club heads are typically formed from stainless steel and other materials (col. 1, ln. 17-20) but it is silent to the use of the claimed metals. Hsieh teaches that Fe-Mn-Al alloys are useful for making castings of golf club heads (col. 1, ln. 7-13). It would have been obvious to one of ordinary skill in the art to have used Fe-Mn-Al as a material for the golf clubs heads of McCabe since it is taught as being suitable for use in such an application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Savage whose telephone number is 571-272-1542. The examiner can normally be reached on M-F 6:30-4:00.

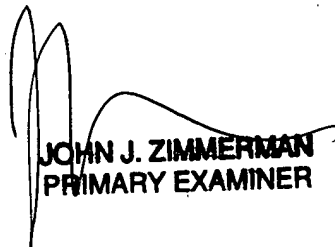
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Savage
10-3-05



JOHN J. ZIMMERMAN
PRIMARY EXAMINER